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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91218523
Party	Plaintiff Oakhurst Industries, Inc. DBA Freund Baking Co.
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

OAKHURST INDUSTRIES, INC. DBA FREUND BAKING CO., Opposer,	)	Opposition No. 91218523
	)	
	)	Application Serial No. 86/139,432
	)	Mark: FREUND'S FAMOUS
	)	Filing Date: December 10, 2013
	)	
v.	)	Application Serial No. 86/139,577
	)	Mark: 
	)	Filing Date: December 10, 2013
	)	
13 <sup>TH</sup> AVE FISH MARKET INC. DBA FREUND'S	)	
FISH,	)	
Applicant	)	

**OPPOSER OAKHURST INDUSTRIES, INC. DBA FREUND BAKING CO.'S MOTION TO  
STRIKE APPLICANT'S AFFIRMATIVE DEFENSES**

Pursuant to Rule 12(f) of the Federal Rules of Civil Procedure ("**FRCP**"), Sections 506.01 and 506.02 of the Trademark Trial and Appeal Board Manual of Procedure ("**TBMP**") and 37 CFR §2.119(c), Opposer Oakhurst Industries, Inc. DBA Freund Baking Co. ("**Opposer**"), respectfully requests that the Trademark Trial and Appeal Board (the "**Board**") enter an order striking Applicant 13<sup>th</sup> Ave Fish Market Inc. DBA Freund's Fish's ("**Applicant**") affirmative defenses from Applicant's Answer to Opposer's Notice of Opposition.

**I. INTRODUCTION AND FACTUAL BACKGROUND**

This action arises out of Applicant's applications to register two trademarks that are confusingly similar to and dilutive of Opposer's famous, federally-registered trademarks and common law trademarks (collectively referred to herein as "**Opposer's Marks**"). In addition, Opposer has pled the grounds of fraud for both of Applicant's applications and mere descriptiveness for one of Applicant's applications as part of Opposer's Notice of Opposition (the "**Opposition**"). Applicant filed Application Serial

No. 86/139,432 for the word mark FREUND'S FAMOUS and Application Serial No. 86/139,577 for the words and design mark  (literal element FREUND'S FAMOUS) (both of the foregoing marks collectively referred to herein as "**Applicant's Marks**") on December 10, 2013.

Applicant's Marks were both published for opposition on August 26, 2014 and Opposer timely filed a Notice of Opposition against both of Applicant's Marks on September 24, 2014. The Opposition stated the basis of Opposer's rights (both at common law and through two federal registrations), and described the reasons why consumers are likely to be confused by Applicant's Marks, and how Applicant's Marks are likely to dilute Opposer's famous marks. The Opposition also explained the additional grounds of fraud for both of Applicant's Marks and the grounds that the mark that is the basis of Applicant's Application Serial No. 86/139,577 is merely descriptive.

In its November 5, 2014 answer to the Opposition (the "**Answer**"), Applicant generally denied, or stated a lack of information to admit or deny, most of the allegations in the Opposition. Applicant also asserted eight "affirmative defenses," which are repeated below in their entirety:

1. "Opposer fails to state a claim upon which relief can be granted."
2. "Applicant's use and registration of its marks as applied to its goods is not likely to cause confusion of any kind with Opposer's alleged use and registration of its mark in connection with its alleged goods and services."
3. "Applicant has used the FREUND'S FAMOUS word mark for at least 40 years for its fish products without any instances of actual confusion with any marks Opposer may apply to its goods."
4. "Applicant has used the FREUND'S FAMOUS design mark for at least five years for its fish products without any instances of actual confusion with any marks Opposer may apply to its goods."
5. "Applicant's use of the federal registration symbol has been inadvertent and without intent to mislead or deceive, and Applicant is discontinuing such use."

6. "Whatever fame Opposer's marks might possess is insufficient for dilution protection under Section 43(c) of the Lanham Act."
7. "Opposer's claims are barred due to laches and acquiescence."
8. "On information and belief, Opposer has not used its mark in connection with "private label baking services" as the specimens of use it submitted to cause the USPTO to issue Registration No. 4500792 do not refer to such services and thus do not meet the requirements of Section 1304.04 Trademark Manual of Examining Procedure et seq."

Opposer's eight affirmative defenses are improperly pled and lack sufficient specificity to put Opposer on notice of their legal and factual bases. Consequently, they are legally insufficient. Moreover, Applicant's affirmative defenses are simply inapplicable to TTAB opposition proceedings or are comprised of redundant, impermissible or immaterial matter. For all of the above reasons, Applicant's affirmative defenses should therefore be stricken in their entirety.

## **II. ARGUMENT**

### **A. All of Applicant's Affirmative Defenses Should Be Stricken Because They Are Inadequately Pled and Lack Supporting Facts**

The Board may strike from any pleading any insufficient or impermissible defense, or any redundant, immaterial, impertinent or scandalous matter. Fed. R. Civ. P. Rule 12(f); TBMP §506.01. According to TBMP Rule 311.02(b), "[t]he elements of a defense should be stated simply, concisely, and directly," and "should include enough detail to give the plaintiff fair notice of the basis for the defense." Conclusory or bald allegations do not provide the plaintiff with fair notice of the basis for the affirmative defenses. *See Id.* (citing *McDonnell Douglas Corp. v. Nat'l Data Corp.*, 228 U.S.P.Q. 45 (TTAB 1985)); *see also Caymus Vineyards v. Caymus Medical, Inc.*, 107 U.S.P.Q. 2d 1519 (TTAB 2013) [Precedential] ("...the claimant must allege well-pleaded factual matter and more than threadbare recitals of the elements of a cause of action, supported by mere conclusory statements...").

The Supreme Court stated that the pleading standard of Rule 8 of the FRCP "...demands more than an unadorned...accusation." *Ashcroft v. Iqbal*, 556 U.S. 662, 678

(2009). “A pleading that offers ‘labels and conclusions...will not do.’” *Id.* (quoting *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 555 (2007)).

An examination of Applicant’s affirmative defenses shows that Applicant does not plead facts to support its affirmative defenses, e.g. “Opposer’s claims are barred due to laches and acquiescence.” As such, each of Applicant’s affirmative defenses are inadequately pled because they merely state conclusions of law and do not state any facts upon which the defenses could be based. Thus, these affirmative defenses fail to put Opposer on notice as to the basis for such defenses. Accordingly, all of Applicant’s affirmative defenses should be stricken in their entirety.

**B. All of Applicant’s Affirmative Defenses Should Be Stricken Because They Are Either Inapplicable to TTAB Opposition Proceedings or Are Comprised of Redundant, Immaterial or Impermissible Matter**

In addition to Applicant’s affirmative defense being inadequately pled and lacking supporting facts, they are also legally insufficient for this type of proceeding and should thus be stricken. If affirmative defenses do not have bearing on a case, they should be stricken. *Ohio State Univ. v. Ohio Univ.*, 51 U.S.P.Q. 2d 1289 (TTAB 1999). Here, Applicant has stated affirmative defenses are not only legally insufficient, they are not possible under the pleaded facts or are comprised of redundant, immaterial or impermissible matter to the proceeding.

**i. Applicant’s First Affirmative Defense**

Applicant’s first affirmative defense states that “Opposer fails to state a claim upon which relief can be granted.” This is not a true affirmative defense because it relates to an allegation of the insufficiency of the pleading of Opposer’s claim rather than a statement of a defense to a properly pleaded claim. See *Hornblower & Weeks Inc. v. Hornblower & Weeks Inc.*, 60 USPQ2d 1733, 1738 n.7 (TTAB 2001). Not only is this not legally sufficient as a defense, it is also impossible when considering the pleaded facts. Opposer has unmistakably stated a claim for opposition, the requirements of which are simply that “[t]he opposition must set forth a short and plain statement showing why the opposer believes he, she or it would be damaged by the registration of the opposed mark and state the grounds for opposition.” 37 CFR §2.104(a). Applicant

did not deny Opposer's statement in the first unnumbered paragraph of the Opposition that Opposer believes that it will be damaged by registration of Applicant's Marks. The Opposer has fulfilled the requirements for pleading its opposition (i.e., standing<sup>1</sup>, priority, basis of likelihood of confusion, basis of likelihood of dilution, basis of fraud and basis of mere descriptiveness). Applicant has not demonstrated otherwise. Quite notably, Applicant admitted in Paragraph 13 of the Answer that Opposer has priority. For all of the foregoing reasons, the first affirmative defense must be stricken.

**ii. Applicant's Second Affirmative Defense**

Applicant's second affirmative defense states that "Applicant's use and registration of its marks as applied to its goods is not likely to cause confusion of any kind with Opposer's alleged use and registration of its mark in connection with its alleged goods and services." This "defense" only restates Applicant's denial of Opposer's allegations and does not raise additional issues and is thus improperly plead. See *Textron, Inc. v. Gillette Co.*, 180 USPQ 152, 153 (TTAB 1973). Therefore, Applicant's Second Affirmative Defense is redundant and should be stricken per FRCP 12(f) and TBMP §506.01.

**iii. Applicant's Third and Fourth Affirmative Defenses**

Applicant's third affirmative defense states that "Applicant has used the FREUND'S FAMOUS word mark for at least 40 years for its fish products without any instances of actual confusion with any marks Opposer may apply to its goods" and its fourth affirmative defense states that "Applicant has used the FREUND'S FAMOUS design mark for at least for at least five years for its fish products without any instances of actual confusion with any marks Opposer may apply to its goods." These defenses plead first use dates wholly inconsistent with Applicant's Application Serial Nos. 86/139,432 and 86/139,577 (and Applicant's statement in Paragraph 57 on the Answer that its first use dates for its Application Serial No. 86/139,577 are correct). More importantly, these defenses are redundant for the same reason that Applicant's second affirmative defense is cited above as redundant: they merely restate Applicant's denial

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<sup>1</sup> It should be noted that "[i]f a plaintiff can show standing on one ground, it has the right to assert any other grounds in an opposition or cancellation proceeding." *TBMP §309.03(b)*.

of Opposer's allegations, do not raise additional issues and are thus improperly plead. *Id.* Accordingly, they should be stricken per FRCP 12(f) and TBMP §506.01.

Moreover, Applicant's third and fourth affirmative defenses should be stricken because they state impermissible and immaterial matter, namely lack of "actual confusion." "The statutory test is likelihood of confusion, not actual confusion." *Wella Corp. v. California Concept Corp.*, 558 F.2d 1019, 1023 (C.C.P.A. 1977) (*Citing In re Bissett-Berman Corp.*, 476 F.2d 640, 641 (C.C.P.A. 1973)). Quite simply put, "[i]t is unnecessary to show actual confusion in establishing likelihood of confusion." *Weiss Associates, Inc. v. HRL Associates, Inc.*, 902 F.2d 1546, 1549 (Fed. Cir. 1990) (*citing Giant Food, Inc., v. Nation's Foodservice, Inc.*, 710 F.2d 1576, 1571 (Fed. Cir. 1984)). As such, "actual confusion" is impermissible and immaterial matter to this proceeding and Applicant's third and fourth affirmative defenses should be stricken per FRCP 12(f) and TBMP §506.01.

**iv. Applicant's Fifth and Sixth Affirmative Defenses**

Applicant's fifth affirmative defense states that "Applicant's use of the federal registration symbol has been inadvertent and without intent to mislead or deceive, and Applicant is discontinuing such use" and its sixth affirmative defense states that "Whatever fame Opposer's marks might possess is insufficient for dilution protection under Section 43(c) of the Lanham Act." The fifth and sixth affirmative defenses are redundant for the same reason that Applicant's second affirmative defense is cited above as redundant: they merely restate Applicant's denial of Opposer's allegations, do not raise additional issues and are thus improperly plead. *See Textron, Inc. v. Gillette Co.*, 180 USPQ 152, 153 (TTAB 1973). Therefore, Applicant's Fifth and Sixth Affirmative Defenses are redundant and should be stricken per FRCP 12(f) and TBMP §506.01.

**v. Applicant's Seventh Affirmative Defense**

Applicant's seventh affirmative defense states that "Opposer's claims are barred due to laches and acquiescence." The defenses of "laches and acquiescence" are inapplicable to this proceeding. As stated by the Board, "the availability of laches and acquiescence is severely limited in opposition...proceedings." TBMP §311.02(b). The

reason for this is because laches and acquiescence “...start to run from the time of knowledge of the application for registration (that is, from the time the mark is published for opposition), not from the time of knowledge of use.” *Id.*; *Sunkist Growers, Inc. v. Smile Factory, LLC*, 937 F.2d 1572, 19 USPQ2d 1424 (Fed. Cir. 1991) (“laches and acquiescence...do not begin to run until the mark is published for opposition.”); *See also National Cable Television Association, Inc. v. American Cinema Editors Inc.*, 937 F.2d 1572, 19 USPQ2d 1424 (Fed. Cir. 1991). Here, Applicant’s Marks were both published for opposition on August 26, 2014 and Opposer timely filed a Notice of Opposition against both of Applicant’s Marks on September 24, 2014. As such, there was no undue delay. Moreover, regarding acquiescence, Applicant has not alleged, nor could it allege that Opposer actively consented to Applicant’s Marks during the publication period.

It should be noted also that laches and acquiescence “...cannot be asserted against a claim of descriptiveness.” *Callaway Vineyard & Winery*, 63 U.S.P.Q.2d 1919 (TTAB 2002). Moreover, such defenses are not available against claims of fraud. *TBMP §311.02(b)*. This makes sense, since there seems to be no factual way such defenses could be asserted against a claim of descriptiveness or fraud.

Accordingly, for all of the above reasons, Applicant’s seventh affirmative defense is comprised of immaterial and impermissible matter to the proceeding and should thus be stricken per FRCP 12(f) and TBMP §506.01.

**vi. Applicant’s Eighth Affirmative Defense**

Applicant’s eighth affirmative defense states that “On information and belief, Opposer has not used its mark in connection with “private label baking services” as the specimens of use it submitted to cause the USPTO to issue Registration No. 4500792 do not refer to such services and thus do not meet the requirements of Section 1304.04 Trademark Manual of Examining Procedure et seq.” Section 1304.04 of the Trademark Manual of Examining Procedure deals with who is eligible to apply for a membership mark. It has no applicability to the present case. As such, Applicant’s eighth affirmative defense is immaterial.



Furthermore, Applicant's eighth affirmative defense also appears to be asserting a basis of fraud by stating "On information and belief, Opposer has not used its mark in connection with "private label baking services"..." "Pleadings of fraud made 'on information and belief,' when there is no allegation of 'specific facts upon which the belief is reasonably based' are insufficient." *Asian and Western Classics B.V. v. Selkow*, 92 U.S.P.Q.2d 1478 (TTAB 2009) (citing *Exergen Corp. v. Wal-Mart Stores Inc.*, 91 USPQ2d 1656, 1670 (Fed. Cir. 2009). Applicant does not support the above allegation with any statement of facts to show why it believes Opposer has not used the mark in Opposer's Reg. No. 4,500,792. Defenses based on fraud have a heightened pleading standard according to FRCP §9 in which they must state the factual basis for such defenses with particularity. See 37 C.F.R. §2.106(b)(1); TBMP §311.02(b). Since Applicant does not cite a single underlying fact in support of its defense that Opposer has not used the mark in Opposer's Reg. No. 4,500,792, this defense does not meet the necessary pleading requirements of fraud and is therefore impermissible.

For all of the above reasons, Applicant's eighth affirmative defense should be stricken per FRCP 12(f) and TBMP §506.01.

### **III. CONCLUSION**

For all of the foregoing reasons, Opposer respectfully requests that all of Applicant's affirmative defenses should be stricken as a matter of law because they are insufficiently pleaded, improper, or otherwise inapplicable. If these affirmative defenses are not stricken, Opposer will be prejudiced as it is forced to devote resources and time to engage in needless and burdensome discovery on these issues. Moreover, because Applicant cannot cure the defects in its legally insufficient, improper and inapplicable "affirmative defenses," they should be stricken with prejudice, and without leave to amend.

Opposer respectfully requests that that the Board suspend the proceeding pending the disposition of this motion and reset the remaining dates in this proceeding upon resumption of the case.

Respectfully Submitted,

/Steven Freund/

Dated: December 1, 2014

By: \_\_\_\_\_

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**PROOF OF SERVICE**

I hereby certify that **OPPOSER OAKHURST INDUSTRIES, INC. DBA FREUND BAKING CO.'S MOTION TO STRIKE APPLICANT'S AFFIRMATIVE DEFENSES** is being electronically transmitted in PDF format to the Trademark Trial and Appeal Board through the Electronic System for Trademark Trials and Appeals (ESTTA) on the date indicated below.

I hereby further certify that a true and complete copy of the foregoing **OPPOSER OAKHURST INDUSTRIES, INC. DBA FREUND BAKING CO.'S MOTION TO STRIKE APPLICANT'S AFFIRMATIVE DEFENSES** was served on counsel for Applicant at the following address by First Class U.S. Mail, postage prepaid, on the date indicated below:

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/Steven Freund/

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Steven A. Freund, Esq

Date: December 1, 2014